

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the below date:
Date: October 10, 2006 Name: John G. Rauch Signature: John G. Rauch

Our Case No. 9623/378

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Paine, Mark et al.)
Serial No. 10/020,712) Examiner Leroux, Etienne Pierre
Filing Date: December 11, 2001) Group Art Unit No. 2161
For RECOMMENDING SEARCH)
TERMS USING COLLABORATIVE)
FILTERING AND WEB SPIDERING)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reasons stated below. No more than five (5) pages are provided.

Introduction

Claims 66-84 are pending in the application. In the final office action dated July 10, the rejection under 35 U.S.C. § 103(a) of claims 66-71 and 73-84 as being unpatentable over U.S. patent number 6,421,675 to Ryan, et al. ("Ryan") in view of U.S. patent number 6,289,341 to Barney ("Barney") was maintained. Additionally, the rejection under 35 U.S.C. § 103(a) of claims 67, 72-74 and 80-82 as being unpatentable over Ryan and Barney and further in view of U.S. patent no. 6,078,916 to Culliss ("Culliss") was also maintained. Reconsideration and allowance of claims 66-84 are respectfully requested.

Overview

The present invention defined by claims 66-84 relates to a computerized search system in which a user enters a keyword and receives matching search results in return. Items in a database are searched to find a match. The items in the database each include a search term and are associated with an information provider such as an advertiser or web site operator, and a bid amount. In an exemplary embodiment, the bid amounts are used to order the matching search results, under control by the information providers who set the bid amounts.

To put information such as advertising before users, an information provider chooses search terms to be added to the database with the goal of attracting the attention of the users. The search terms should be descriptive or related to advertising or other information of the information provider. The presently claimed invention provides for recommending search terms to a new information provider, i.e., one who has not previously stored search terms on the database or associated search terms with himself. Because the advertiser or information provider may not know what search terms to specify, or may wish to have other search terms than he can think up spontaneously, the advertiser may seek recommendations of other search terms.

The method acts of claim 66 define how search terms or keywords are recommended to one such information provider, particularly a “new information provider” who is establishing search listings on the computer network search apparatus.

The “new information provider” of claim 66 is an advertiser or other individual operating his computer system, not a search engine.

The Final Office Action has considered the claim language and Ryan and concluded that the “new information provider” recited in claim 66 reads on the search engine disclosed by Ryan. It is respectfully submitted that a “new information provider” in the context of claim 66 is an individual (and his computer system), not a search engine. The present application, at page 10, lines 24-31, explains:

For example, one class of users located at client computers 12 may be **network information providers** such as advertising web site promoters or owners having advertiser web pages 30 located on advertiser web servers 14. These advertising web site promoters, or advertisers, may wish to access account information residing in storage 32 on account management server 22. An advertising web site promoter may, through the account residing on the account management server 22, participate in a competitive bidding process with other advertisers.

(emphasis added). Thus, the parties involved with the system recited in method claim 66 include a user who enters information through an input device and information providers which are associated with items stored in the database. A new information provider is one who has not previously stored search terms on the database. The Final Office Action asserts that “a ‘new information provider’ is not described in the specification such that the claim language can be interpreted in light of the specification.”

As demonstrated herein, the meaning of the noted terminology is clear from the specification. Moreover, the Final Office Action asserts that “MPEP Section 2106 requires Office personnel to give claims their broadest reasonable interpretation in light of the supporting disclosure.” It is respectfully submitted that interpreting the claim term “new information provider” as a search engine as disclosed in Ryan is an unreasonably broad interpretation. The specification including the quoted above makes clear that information providers are individuals (and their computer systems), not a search engine.

Once the parties are more clearly identified, it becomes apparent that Ryan actually relates to keyword suggestion for a user of the search system, not an information provider.

The cited art does not show suggesting keywords to an information provider

Ryan actually relates to a database search system which provides keyword suggestions to a user of the search system. Ryan’s search process is described at column 4, lines 30-40. The Ryan system suggests keywords to the user based on a keyword that the user entered. Col. 7, lines 63-66; col. 8, lines 28-32.

Since the keywords are suggested to the user, Ryan cannot disclose the present invention of claims 66-84 which relates to suggesting keywords to an information provider. Information providers are present in the system disclosed by Ryan, e.g., FIG. 1B “Developer site/computer” 104A, B; column 4, lines 3-11. However, Ryan’s keyword suggestion feature serves the user who submits search requests, not the developer who provides content and other information. Ryan does not even recognize the problem solved by the presently claimed invention, that an information provider might want or need some suggestion of keywords to bid upon.

Since Ryan is directed to a different problem, Ryan fails to disclose many limitations of the present claims. For example, claim 66 recites “obtaining a set of

potential search terms for acceptance by a new information provider who is adding items to the database.” Ryan does not relate to a new information provider or potential search terms for acceptance by such an information provider. Further, as another example, claim 66 recites “sorting the potential search terms according to the computed estimated ratings” and “presenting to the new information provider on an output device the sorted potential search terms.” For the former quoted limitation, the Final Office Action can cite no equivalent in Ryan. For the second quoted limitation, the Final Office Action refers to Ryan’s Surfer keyword list at column 8, lines 15-20. However, the Surfer keyword list is described as “a data set comprised of a list of key-words that the individual user found useful after the keyword was selected” (*emphasis added*). Thus, in accordance with the fundamental distinction between Ryan and the presently claimed invention, the Surfer keyword list is a user feature, not a list presented to the new information provider. Ryan just does not relate to the problem solved by the claimed invention. As a result, many limitations of claims 66-84 are not disclosed by Ryan.

The Final Office Action relies on Barney as disclosing claim 66, step (b) “computing correlations.” However, Barney describes a “site examiner” which traverses web sites of others and makes comparisons between web site data and “IP indicia,” or information about an owner’s intellectual property. The site examiner may use correlations for this comparison. However, Barney does not show or suggest “computing correlations between the potential search terms for the new information provider and search terms of other information providers stored in the database” as recited by claim 66. First, Barney is not related to potential search terms of a new information provider. Second, in the limitation of claim 66, relevant information is stored in “a database” and the correlations are computed on data stored in the database. Barney teaches crawling others’ web sites and performing correlations on the crawled data. Accordingly, Barney does not provide the missing teaching. Barney is even more remote than Ryan from the present invention defined by claims 66-84.

Moreover, the keyword suggestion techniques of Ryan, for suggesting keywords to a user or searcher, can not be properly extended to a keyword suggestion device and method for an information provider, such as the method and apparatus in accordance with claims 66-84. The new information provider may not know what search terms to specify,

or may wish to have a broader range of search terms than he can think up spontaneously, and therefore the information provider may seek recommendations of other search terms.

In contrast, a user generally seeks a narrower, more focused range of results when he enters a search terms, as Ryan explains at column 1, lines 41-58. Ryan's device then provides

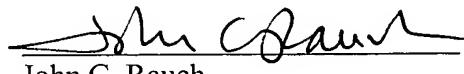
a method of updating an internet search engine database with the results of a user's selection of specific web page lists from the general web page listing provided to the user as a result of his initial keyword search entry. *By updating the database with the selections of many different users*, the database can be updated to prioritize those web listings that have been selected the most with respect to a given keyword, and hereby presenting first the most popular web page listings in a subsequent search using the same keyword search entry (*emphasis added*).

Ryan, column 2, lines 27-36.

Accordingly, even though both Ryan and the presently claimed invention broadly provide "keyword suggestion," it is not proper to extend Ryan's device to the problem of keyword suggestion for information providers. And even if this extension is made, Ryan simply operates differently to provide keywords to users. The claimed method and apparatus make search term recommendations based on the contents of *the information provider's own web site* and by comparing the advertiser to *other similar information providers* and recommending search terms they have chosen. Ryan is not related to this process. Accordingly, it is submitted that claim 66 is allowable over the cited references.

While only claim 66 has been discussed in detail herein, it is submitted that independent claim 79 includes similar limitations and is allowable for the same reasons. Withdrawal of the rejections of claims 66-84 and allowance of the application is respectfully requested.

Respectfully submitted,



John G. Rauch
Registration No. 37,218
Attorney for Applicant

October 10, 2006
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200